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Shawn Wayans, Marlon Wayans,
7 Wayans Bros. Productions, and
SMP, LLC incorrectly named St. Martin's
8 Press, Inc. (now known as SMP (1952) Inc.)
9

10 **UNITED STATES DISTRICT COURT**
11 **CENTRAL DISTRICT OF CALIFORNIA**
12

13 JARED EDWARDS,

14 Plaintiff

15 vs.
16

17 KEENEN IVORY WAYANS,
18 SHAWN WAYANS, MARLON
19 WAYANS, WAYANS BROTHERS
20 PRODUCTIONS, AND ST.
21 MARTIN'S PRESS, INC.,

22 Defendants.
23

) CASE NO. 2:10-cv-02231 R (RCX)
)
) [*Honorable Manuel Real,*
) *Courtroom 8, USDC - Central District*]
)
) **NOTICE OF MOTION AND JOINT**
) **MOTION FOR SUMMARY**
) **JUDGMENT PURSUANT TO FED.**
) **R. CIV. P. 56(b), OR IN THE**
) **ALTERNATIVE, MOTION FOR**
) **SUMMARY ADJUDICATION;**
) **MEMORANDUM OF POINTS AND**
) **AUTHORITIES**
)
) Date: January 18, 2011
) Time: 10:00 a.m.
) Location.: Courtroom 8
)
) [Filed Concurrently With Statement of
) Uncontroverted Facts and Conclusions
) of Law; Declarations of Jay S. Glick,
) September Rea and Elizabeth Beier;
) Request for Judicial Notice and
) [Proposed] Order Granting Summary
28 Judgment]

TO ALL PARTIES AND THEIR COUNSEL OF RECORD:

PLEASE TAKE NOTICE that on January 18, 2011, at 10:00 a.m., or as soon thereafter as this matter may be heard, before the Honorable Manuel Real in Courtroom 8 of the United States District Court located at 312 N. Spring Street, Los Angeles, California, 90012, defendants Keenen Ivory Wayans, Shawn Wayans, Marlon Wayans, and Wayans Bros. Productions (hereinafter the “Wayans”) and St. Martin’s Press, Inc. (now known as SMP (1952) Inc.) (“SMP”) (collectively “Defendants”) will, and hereby do, move jointly and severally for summary judgment with respect to all claims and causes of action asserted in Plaintiff Jared Edwards’s (“Plaintiff”) Complaint pursuant to Federal Rule of Civil Procedure 56(b) on the following grounds:

1. Plaintiff’s first cause of action for violation of the Copyright Act of 1976 (the “Act”) fails as a matter of law against all Defendants because Plaintiff has not presented any evidence to rebut the presumption that the Wayans exclusively owned the copyright to the subject work under the work for hire doctrine and as a result, neither the Wayans nor SMP violated the Act by contracting to publish the work. Further, and in the alternative, to the extent Plaintiff independently contributed to the work (as he claims) it was to create a “joint work” co-authored by the Wayans and Plaintiff. As a result, the Wayans owned an undivided interest in the work so that there has been no infringement by the Wayans or SMP.

2. Plaintiff’s second cause of action for unfair competition under state law fails as to all Defendants because it is preempted by federal copyright law. To the extent that the Court finds that the claim survives preemption, the unfair competition claim still fails as a matter of law because Plaintiff has not presented any evidence that any of the named Defendants engaged in unfair, unlawful, or fraudulent business practices.

///

1 3. Plaintiff's third cause of action for breach of implied contract fails as
2 to all Defendants because it is preempted by federal copyright law. To the extent
3 that the Court finds that the claim survives preemption. Plaintiff cannot provide
4 prima facie evidence to support all of the elements of a breach of implied in fact
5 contract claim.

6 To the extent the Court declines to grant this motion for summary judgment
7 as to all Defendants on all claims, Defendants move, jointly and severally, in the
8 alternative for an order summarily adjudicating what types of damages Plaintiff
9 may recover. This motion for summary adjudication is made on the following
10 grounds:

11 1. As a matter of law, Plaintiff is not entitled to statutory damages or
12 recovery of attorneys' fees under the Act because it is undisputed that the
13 unpublished work was not registered with the United States Copyright Office at the
14 time of the alleged infringement as required by the Act (17 U.S.C. § 412);

15 2. As a matter of law, Plaintiff's recovery for unfair competition is
16 limited to restitutionary relief and injunctive relief. Plaintiff cannot recover
17 damages (including punitive damages) or attorneys' fees pursuant to an unfair
18 competition claim; *and*

19 3. As a matter of law, Plaintiff is not entitled to attorneys' fees or
20 punitive damages for breach of implied in fact contract.

21 The motion is based upon this Notice and Motion for Summary Judgment,
22 the attached Memorandum of Points and Authorities, the accompanying Separate
23 Statement of Undisputed Facts and Conclusions of Law; Declarations of Elizabeth
24 Beier, September Rea, Jay S. Glick, and Paul Sleven, the Joint Request to Take
25 Judicial Notice, all other pleadings and papers on file herein, and on such oral
26 argument and other evidence as may be allowed by the Court at the time of the
27 hearing on this Motion.

28 ///

1 Dated: December 17, 2010 FREEDMAN & TAITELMAN, LLP

2 By: /s/

3 Bryan J. Freedman, Esq.

4 September Rea, Esq.

5 Attorneys for Defendants Keenen Ivory Wayans,

6 Shawn Wayans, Marlon Wayans, Wayans Bros

7 Productions, and St. Martin's Press, Inc. (now known as
8 SMP (1952) Inc.)
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MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

The subject matter of this litigation is the illustrated joke book “101 Ways to Know You’re a Golddigger” (“*Golddigger*”) authored by Keenen Ivory Wayans, Marlon Wayans, and Shawn Wayans and published by St. Martin’s Press, LLC (“SMP”)¹ in June 2009. The book is one in a three-book series referred to as the “101 Ways” Series. Plaintiff Jared Edwards, a former Wayans employee, claims that he owns the copyright to the text of *Golddigger*. Irrefutable evidence shows, however, that to the extent Plaintiff worked on *Golddigger*, it was alongside the Wayans in the context of his employment with a team of other Wayans employees including illustrators. The Wayans are the authors of the work and neither the Wayans nor SMP have acted unlawfully. Edwards may harbor hurt feelings for not having received credit on the finished product of *Golddigger*, but this does not provide a basis for federal litigation.

II. STATEMENT OF FACTS

A. Parties to the Action

Plaintiff Jared Edwards (“Plaintiff” or “Edwards”) is a California resident. (STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW (“SF”) 1.) Defendants Keenen Ivory Wayans, Marlon Wayans, Shawn Wayans (the “Wayans”) are also California residents and celebrity comic writers, directors and actors. (COMPL. ¶¶ 7, 9, 12; SF 2-4.) Defendant Wayans Bros. Productions, Inc. is a California corporation of which the Wayans are the exclusive principals. (SF 5.)

B. Plaintiff’s Employment Relationship with Wayans Defendants

Plaintiff worked for the Wayans in one capacity or another for the better part of a decade – from sometime in or around 1995 (SF 7) until sometime in or around

¹ Though notified that St. Martin’s Press, Inc. (now SMP (1952) Inc.) did not publish the book at issue, Plaintiff has not amended his Complaint to properly name St. Martin’s Press, LLC. (SF. See generally COMPL. (naming St. Martin’s Press, Inc.).)

1 October 2006 – with the exception only of one period of time when he says he took
 2 a “sabbatical.”² (SF 18) Plaintiff has otherwise been employed by the Wayans
 3 ever since he recognized Keenan Ivory Wayans on the street (SF 19) and talked to
 4 him about “wanting to write for him” (SF 20), explaining that he was “just trying
 5 to find [a] way in” (SF 21); he wanted “to break into writing and acting” (SF 22),
 6 he “wanted to do it all.” (SF 23.) One month later, Plaintiff was hired as a
 7 production assistant and a runner on the Keenan Ivory Wayans Show. (SF 24.)
 8 Since then, Plaintiff has worked for the Wayans in a chameleonic fashion, doing
 9 whatever needed to be done to “to assist overall production,” (SF 25) whether on
 10 set, on location, or in the office (SF 25) in support of whatever creative endeavor
 11 the Wayans were working on at the time.

12 Plaintiff describes the nature of his work with the Wayans as “open-ended.”
 13 (SF 26) Over the years, Plaintiff has worked for the Wayans on movies (SF 27),
 14 television shows (SF 28), award shows, (SF 29) at stand-up gigs (SF 30), as a
 15 personal assistant (SF 31), a production assistant (SF 32), a runner (SF 33), doing
 16 extra work as an actor (SF 34), and working with Wayans’ writers “punching up”
 17 jokes (SF 35). He says he was “always on call” (SF 36) and did “whatever was
 18 needed.” (SF 37) He traveled with them frequently, often on a private plane (SF
 19 38), to places like New York (SF 39), Paris and London (SF 40) He stayed in
 20 luxury hotels and went to elite night clubs on a VIP basis (SF 41,42). The Wayans
 21 financed these extravagancies and also paid his salary. (SF 43)

22 Although he chose to remain on the Wayans’s payroll in some capacity or
 23 another for the better part of ten years, Plaintiff says he sometimes felt that his
 24 employment with the Wayans was “not fair.” (SF 44) He felt they expected him
 25

26 ² Plaintiff says he freelanced during his “sabbatical” but could not describe what he did or for
 27 how long. (SF 8-11, 13, 14) He went through a “rough period” when he was not working for the
 28 Wayans. (SF 15) He was behind on his credit card bills and car payment and was about to
 be evicted from his apartment (SF 16) until Shawn Wayans offered to loan and did loan him
 \$12,000. (SF 17) Shortly thereafter, the Wayans rehired Plaintiff. (SF 12)

1 to “jump up and do things right away” just because [they] “wrote [his] checks.”
 2 (SF 45) He wanted the Wayans to “appreciate [his] hard work [and not] write it off
 3 as not being anything.” (SF 46) He complains that he was “always on the clock
 4 with them” even when they went to clubs and were otherwise socializing, he was
 5 “always working.” (SF 47) But, alas: “That was [his] job. It was either do that or
 6 not be working.” (SF 48)

7 **C. The Wayans Developed the 101 Ways Series.**

8 In 2005, Plaintiff was working as a full-time employee for the Wayans
 9 through their production company Wayans Bros. Productions. (SF 49) The
 10 Wayans paid Plaintiff as a full-time employee through a W2 form and also paid
 11 payroll and social security taxes for him. (SF 50.) Around this time, Plaintiff
 12 alleges he became aware that his employers were working on creating a series of
 13 books based on a style of joke book that Shawn Wayans had authored and
 14 published through Dell Publishing in 1997: “150 Ways To Tell If You’re Ghetto.”
 15 (SF 51, 52) Plaintiff understood the Wayans were going to “dust off [this]
 16 property” and create a new series of illustrated joke books each with a separate
 17 theme, such as 101 Ways to Know Your Mama’s Ghetto (“101 Series” or “101
 18 Project”). (SF 53.) Plaintiff wanted to “get in on” the 101 Project and began
 19 writing jokes that he wanted to be “included in that property.” (SF 54.) He
 20 thought that if it “happened to be good enough, it would go through the process of
 21 the artist illustrating it and [the Wayans] finding someone to do it.” (*Id.*) This
 22 endeavor “[w]as a means for advancement” to a “earn a much more creative
 23 position.” (SF 55.)

24 Accordingly, Plaintiff says he commenced work on various jokes for
 25 inclusion in the 101 Series, including *Golddigger*. His work on the project was
 26 proscribed by his employer’s guidelines, including the layout of the book, the
 27 number of jokes and the number of illustrations. (SF 56, 57.)

28 Edwards claims that he worked on his first draft mostly at home and at the

1 office after hours. (SF 58) He says he did not show it to his employer until it was
2 complete, at which time he says he dropped it off at Keenen Ivory Wayans's home.
3 (SF 59) He does not allege that he provided any written or verbal notice of
4 confidentiality nor conditional terms of review. (SF 60) Upon review by his
5 employer, Plaintiff was encouraged to proceed and was tasked with various
6 responsibilities pertaining to the 101 Series. (SF 61) Plaintiff received group work
7 emails about *Golddigger* and other proposed titles for inclusion in the 101 Series
8 from the project manager who was coordinating the overall project. (SF 62 ("This
9 was during the time I was still employed with them, so because it was my book
10 ...anything that happened with them, I was always e-mailed a copy.")) He even
11 worked with at least one Wayans's illustrator and sat down to talk about the
12 selection of drawings. (SF 63) Plaintiff understood that the Wayans had the
13 ultimate authority to approve, modify or reject the jokes. (SF 64.) Plaintiff claims
14 he left the employment of the Wayans on his own volition even though the 101
15 Project was ongoing. (SF 65.) He did not ask the Wayans about the status of the
16 101 Series before or after his departure. (SF 66.)

17 On or about June 9, 2009, two of the titles in the 101 Series (*Golddigger* and
18 *Mama's House*) were published in paperback by St. Martin's Press, LLC who
19 contracted with the Wayans to publish the book. (SF 67.) Shortly thereafter, the
20 Wayans registered *Golddigger* with the U.S. Copyright Office, which issued a
21 copyright registration certificate effective July 6, 2009. (SF 68, Declaration of
22 September Rea, Ex. 1, "101 Ways to Know You're a Golddigger"). Plaintiff
23 claims that he was surprised to discover that the 101 Series was published. (SF
24 69.) Subsequently, Plaintiff registered a copy of his alleged list of golddigger
25 jokes (without illustrations) with the U.S. Copyright Office and was issued a
26 copyright registration certificate effective August 23, 2009. (SF 70) Plaintiff then
27 initiated this Action. (SF 71)

28 ///

III. SUMMARY JUDGMENT STANDARD

Defendants have no burden to negate or disprove matters on which Plaintiff has the burden of proof. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). Rather, Plaintiff satisfies Rule 56 by “showing--pointing out to the district court--that there is an absence of evidence to support [Plaintiff’s,] the non-moving party’s[,] case.” *Id.* at 325. A failure of proof concerning an essential element renders all other facts immaterial, and summary judgment must be granted. *Id.* at 323. A factual dispute bars summary judgment *only* if the nonmovant’s evidence is sufficient to require trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249-50 (1986). If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted. *Id.*

IV. COPYRIGHT CLAIM FAILS AS A MATTER OF LAW

A. Plaintiff’s Copyright Claim Fails as to All Defendants Because Any Contribution Was Made on a “Work For Hire” Basis.

Plaintiff claims that Defendants have infringed his copyrighted work in violation of the Copyright Act of 1976, 17 U.S.C. §§ 101 *et seq.* (the “Act”). Under section 201(a) of the Copyright Act, the copyright in a protected work vests initially in the author or authors of the work. 17 U.S.C. § 201(a). In the case of a work made for hire, however, “the employer or other person for whom the work was prepared is considered the author . . . and, unless the parties have expressly agreed in a written instrument signed by them, owns all of the rights comprised in the copyright.” 17 U.S.C. § 201(b). A work prepared by an employee within the scope of his or her employment is a “work made for hire” as defined under section 101 of the Copyright Act.³ Summary judgment is appropriate where there is no genuine issue of material fact as to the applicability of the work for hire doctrine.

³ In addition, certain works specially ordered or commissioned can be works for hire under the Act where a written agreement between the parties exists; however, this application of the work for hire doctrine is not relevant to the facts of this case. Edwards was not an independent contractor and the parties did not have a written agreement governing the copyright to the work.

1 *E.g., S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1086 (9th Cir. 1989).

2 1. Edwards was a Full Time Employee of the Wayans.

3 Although the term “employee” is not defined by the Act, the Supreme Court
 4 has clarified that its meaning should be construed within the scope of traditional
 5 agency law. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989)
 6 (“*Reid*”). In *Reid*, the Supreme Court analyzed multiple factors to ascertain
 7 whether the plaintiff was an independent contractor or an employee using the
 8 general principles of agency law. Factors that are said to be “significant in
 9 virtually every situation” include: (1) the provision of employee benefits; (2) the
 10 tax treatment of the hired party, (3) the skill required; (4) the hiring party’s right to
 11 control the manner and means of creation; and (5) whether the hiring party has the
 12 right to assign additional projects to the hired party. *Aymes v. Bonelli*, 980 F.2d
 13 857, 861 (2d Cir. 1992).

14 Edwards was a “formal, salaried employee” of the Wayans during the
 15 relevant time period and thus an “employee” under the most restrictive test of
 16 employment. *See Dumas v. Gommerman*, 865 F.2d 1093 (9th Cir. 1989)
 17 (discussing formal indicia of employment applied before the more flexible
 18 evaluation of *Reid*). Moreover, the circumstances of Plaintiff’s employment are
 19 opposite to those of *Reid* where the plaintiff that was found not to be an employee.

20 First and foremost, the Wayans filed a W2 on Edwards’s behalf, and they
 21 paid payroll and/or Social Security taxes for him as a full time employee (SF 50).
 22 *Cf. Reid*, 490 U.S. at 753; *Aymes*, 980 F.2d at 861 (noting that payment status of
 23 taxes is “highly indicative” if not dispositive of employment status). In addition,
 24 unlike the plaintiff in *Reid*, Plaintiff did not work in a separate city from his
 25 employer but instead worked in the Wayans’s proximity, either in their established
 26 production offices, on location with them, or at their individual homes (SF 72), and
 27 thus was “supervised on a daily basis.” *Cf. Reid*, 490 U.S. at 753. Finally, as his
 28 full-time employers, the Wayans had the right to assign additional projects to

1 Edwards, and indeed they did on a regular basis. (*E.g.*, SF 73.) Edwards
 2 performed a variety of duties and worked on a range of products based on
 3 “whatever they needed.” (SF 37) Edwards’s status as a full time employee is not
 4 an issue of dispute.

5 2. Any Work by Edwards on *Golddigger* Was Done Within the
 6 Scope of Edwards’s Employment.

7 Just as the Supreme Court relies on the Restatement of Agency
 8 (“Restatement”) to define who is an employee (*Reid*, 490 U.S. at 753), courts rely
 9 on the Restatement to determine whether the employee’s conduct falls within the
 10 scope of his employment. 1-5 NIMMER ON COPYRIGHT §5.03 (B)(1)(b).
 11 Specifically, courts focus their analysis on whether (1) it was the kind of work he
 12 is employed to perform, (2) it occurs substantially within work hours and space,
 13 and (3) it was actuated, at least in part, by a purpose to serve the employer. *Id.* See
 14 also, *e.g.*, *Shaul v. Cherry Valley-Springfield Cent. Sch. Dist.*, 363 F.3d 177, 186
 15 (2d Cir. 2004) (holding school owned copyright in tests, quizzes and homework
 16 problems created by teacher because “kind of work” teacher was employed to
 17 perform, he was motivated by duties as a teacher though he may also have had a
 18 desire to publish the materials, and that it did not matter that he created the work
 19 off of the school premises or not during work hours).

20 a. *Drafting jokes to include in the 101 Ways Project was the*
 21 *“kind of work” Edwards was employed to perform.*

22 An employee does not have to have been hired for the specific purpose of
 23 creating the copyrighted subject matter for it to be the “kind of work” he was
 24 employed to do. The creation of the work is within the scope of employment
 25 where it is “***within the ultimate objective of the principal and [is] an act which it***
 26 **is not unlikely that such a servant might do.** RESTATEMENT (SECOND) OF
 27 AGENCY § 229, cmt. B. “The fact that a particular employer has no reason to
 28 expect the particular servant to perform the act is not conclusive.” *Id.*; see also

1 *Miller v. CP Chemicals, Inc.*, 808 F.Supp. 1238 (D.S.C. 1992) (computer program
 2 created by lab supervisor” within scope of employment where “within the ultimate
 3 objective of the principal and an act which is not unlikely that a servant might
 4 do”). This analysis is particularly appropriate when an employee’s duties are
 5 “open-ended.” *See Genzmer v. Public Health Trust of Miami-Dade County*, 219
 6 F.Supp. 2d 1275, 1276-80 (S.D. Fla. 2002). In *Genzmer*, the Court held that
 7 authorship of computer programs fell within the ambit of the “kind of work” a
 8 medical doctor was “hired to perform” where the nature of the research program
 9 the doctor was participating in was “open-ended” and “myriad activities”
 10 comprised his responsibilities. In addition, a supervisor’s awareness of,
 11 encouragement of, or control over the project or work in question militates towards
 12 a finding that the work is within the scope of employment and thus a work for hire.
 13 For example, in *Genzmer*, the court found it instructive that the doctor in *Genzmer*
 14 “apprized his supervisor . . . about his activities” and the supervisor provided
 15 “guidance and praise.” *Id.* at 1281.

16 Here, Plaintiff describes the parameters of his work with the Wayans as
 17 “open-ended,” (SF 26), whereby he was “always on call” (SF 36) to do “whatever
 18 was needed.” (SF 37) Plaintiff states that his job was “to assist overall
 19 production,” whether on set, on location, or in the office (SF 25). Over the years,
 20 he worked on behalf of the Wayans on movies (SF 27), television shows (SF 28),
 21 award shows (SF 29), stand-up gigs (SF 30), as a personal assistant (SF 31), a
 22 production assistant (SF 32), a runner (SF 33), doing extra work as an actor (SF
 23 34), and working with Wayans writers punching up jokes to make them funnier
 24 (SF 35). Most recently, before he claims he quit on his own accord, Plaintiff was
 25 working on the 101 Ways Series. (SF 74) There is no dispute that the parameters
 26 of Edwards’s employment were not well defined and his responsibilities varied
 27 depending on the needs of the Wayans. Plaintiff concedes that any jokes penned
 28 by him were created to further the development of the 101 Series, a Wayans’s

1 “property” he knew they were “dusting off” and that he wanted to work on. (SF
 2 54) The contribution of jokes for use in a project that his comedic-writer
 3 employers were working on was exactly in line with the “ultimate objective” of
 4 Wayans Bros. and the Wayans.

5 In addition, Plaintiff contends the *Golddigger* material he proposed for
 6 inclusion in the 101 Ways Series was well-received by the Wayans: they were
 7 “excited over it” and “made him aware” that he “could possibly have an
 8 opportunity . . . to get credit and finally be recognized.” (SF 75) They assigned
 9 him to the office team working on the 101 Ways Project as a writer whereby his
 10 jokes were subject to a variety of input and multiple edits (SF 76) and where there
 11 was “formal” office involvement including a “production manager” to coordinate
 12 with “all of the people who were working on the 101 Ways Series” including the
 13 artists and the writers (SF 77). On top of all that, the “*final say-so came from*
 14 *Shawn and Marlon and Keenen. No one made a decision over them. . . .No one*
 15 *okayed [anything] but them.*” (SF 78) The evidence is undeniable that assisting
 16 with drafting jokes for inclusion in a Wayans’s publication was the “kind of work”
 17 Plaintiff was hired to perform and indeed was performing openly in the context of
 18 his employment. *See Genzmer*, 219 F.Supp. 2d at 1276-80.

19 b. *Any work Edwards alleges to have done on Golddigger*
 20 *occurred substantially within work hours and space.*

21 The next inquiry under the Restatement factors is whether the work occurred
 22 “substantially within work hours and space.” Nevertheless, a work may be within
 23 the scope of an employee’s duties even if it was prepared at home during
 24 nonworking hours. *See Shaul*, 363 F.3d at 186 (teacher’s work deemed “for hire”
 25 despite being created at home); *Genzmer*, 19 F.Supp. 2d at 1280 (doctor developed
 26 work-for-hire computer program in his home, using his home computer, during
 27 off-duty hours); *McKenna v. Lee*, 318 F. Supp. 2d 296, 298 (E.D.N.C. 1984), *aff’d*
 28 *mem.*, 53 Fed. Appx. 268 (4th Cir. 2002) (work was made “for hire” even though

1 plaintiff created it during nonworking hours).

2 Here, Plaintiff asserts that given the nature of his job, the Wayans knew
 3 everything he was working on, because “yeah, they were [his] bosses” (SF 79), he
 4 was “always on the clock with [the Wayans]” (SF 80) “always working” (SF 81),
 5 “in the office every day” (SF 82). He claims he worked on the manuscript
 6 sometimes at the office on his computer but also “wherever [he] was.” (SF 83)
 7 Indeed, Plaintiff testified that the entire office was working on the 101 Ways
 8 Project, including *Golddigger*. (SF 84) Plaintiff received work emails about the
 9 project (SF 62), used office resources to work on the project (SF 83), and
 10 collaborated with others as part of his job while on the clock at work. (SF 85) The
 11 fact that he may have also brought his work home or worked at the office after
 12 hours does not alter the conclusion that Plaintiff’s contributions were created
 13 “substantially within work hours or space.”

14 c. *The drafting of any jokes by Edwards for inclusion in*
 15 *Golddigger was actuated, in whole or in part, by a purpose*
 16 *to serve the Wayans.*

17 There is “no need for the employer to suggest any particular project” for it to
 18 be motivated by a desire to serve the employer. *Martha Graham Sch. & Dance*
 19 *Found. v. Martha Graham Ctr. of Contemporary Dance, Inc.*, 380 F.3d 624, 640
 20 (2d Cir. 2004) (stating also that “[t]here is no need for the employer to be the
 21 precipitating force behind each work created by a salaried employee, acting within
 22 the scope of her regular employment”). Evaluation of whether the work was
 23 “actuated” at least in part to “serve” the principal is informed by the “instance
 24 test,” which examines (in the context of the 1909 Copyright Act) whether “the
 25 motivating factor in producing the work was the employer who induced the
 26 creation.” *See 20th Century Fox Film Corp. et al v. Ent’t Dist. et al*, 429 F.3d 869,
 27 878 (9th Cir. 2005); *Playboy Ent., Inc. v. Dumas*, 53 F.3d 549, 554 (2d Cir. 1995).

28 The degree to which the “hiring party had the right to control or supervise

1 the artist's work informs the analysis of whether the work was created at the
 2 "instance of" the employer, and in turn, whether its creation was "actuated" or
 3 "motivated" by a desire to serve the employer. *See 20th Century Fox Film Corp.*,
 4 429 F.3d at 879 (citing *Self-Realization Fellowship Church v. Ananda Church of*
 5 *Self Realization*, 206 F.3d 1322, 1326 (9th Cir. 2000) (finding "no evidence of
 6 supervision or control" to satisfy applicable work for hire doctrine)). Limited
 7 supervisory powers are sufficient to meet the requisite level of control: "complete
 8 control over the author's work is not necessary." *20th Century Fox Film Corp. et*
 9 *al.*, 429 F.3d at 880 ("sufficient supervisory powers" existed where publisher
 10 "discuss[ed] possible improvements with the author," had "face to face meetings,"
 11 and provided "notes and comments" on the work). *See also Picture Music, Inc. v.*
 12 *Bourne*, 457 F.2d 1213, 1217 (2d Cir. 1972) (supervision sufficient to survive
 13 "instance" test where party had power to "accept, reject, or modify [the] work");
 14 *Playboy*, 53 F.3d at 556 (employer was "motivating factor" in the creation of
 15 artist's paintings where artist would not have created "those particular paintings" if
 16 he had not been given the assignments by Playboy despite the fact that his work
 17 was not overseen by Playboy).

18 The record here is unequivocal that Plaintiff was "actuated" or "motivated"
 19 by a desire to serve his employers. Plaintiff admits as much. He testified he was
 20 working as a full-time employee when he started drafting jokes (SF 86) "in the
 21 same vein" as the 150 Ways book previously published by the Wayans (SF 86)
 22 because he knew the Wayans "already were trying to dust that property off," and
 23 that the reason he says he wrote the *Golddigger* jokes was so that [he] could have a
 24 book included in that property." (SF 86.) He knew that "the artists were already
 25 on staff, so [his] reasons for writing the book [were that] if it happened to be good
 26 enough, it would go through the process of the artist illustrating it and [the
 27 Wayans] finding someone to do it. . . . [he] envisioned to write a book that would
 28 take [him] from being an assistant runner to progressing [him]self" internally. (SF

1 87.) Plaintiff's stated goal was thus "to write as much as [he] could to try and see
 2 what could 'get on' [the 101 Project]." (SF 88.) As Plaintiff states in an email he
 3 wrote to the Wayans's full-time "production manager" of the project, he wrote the
 4 jokes "as a means for advancement" to a "earn a much more creative position" (SF
 5 55.) He was hoping the Wayans "liked" his jokes and he "could get [his] chance
 6 off that." (SF 89.)

7 Moreover, it is clear that he would not have written this particular style of
 8 book but for the specifications provided by his employer. *See Playboy*, 53 F.3d at
 9 556. Indeed, Plaintiff says he chose "the style of book to have jokes married with
 10 illustrations" rather than just a "regular book" or a "script" because the 101 Series
 11 "was a property that [the Wayans] already had . . . [and he] wanted to get a project
 12 going . . . [so he chose to] write something that had potential to get on, and at the
 13 time, this was something they were trying to do. They were trying to do this
 14 series again." (SF 56) His work on the project was thus proscribed by his
 15 employer's guidelines. He knew "that the goal was to reach 101" jokes, because
 16 "that was the name of the property" so he would try "to give [the Wayans] the best
 17 options for the funniest jokes." (SF 90.)

18 Finally, sufficient supervisory powers existed here where the Wayans had
 19 face to face meetings with Plaintiff and provided notes and comments (SF 91) on
 20 the work (*20th Century Fox Film Corp.*, 429 F.3d at 880) in addition to retaining
 21 the ultimate authority to "accept, reject, or modify [the] work." *Picture Music*, 457
 22 F.2d at 1217. As Plaintiff testified, in the end, the "final say-so came from Shawn
 23 and Marlon and Keenen. No one made a decision over them. . . .No one okayed
 24 [anything] but them." (SF 78)

25 The record is clear that to the extent Plaintiff did draft jokes for *Golddigger*,
 26 the work was created in the scope of Plaintiff's full-time employment with the
 27 Wayans and is thus presumed by operation of law to be a work for hire. Plaintiff
 28 has not submitted any evidence to contradict this presumption. As a result, the

1 Court should dismiss Plaintiff's copyright claim as a matter of law against all
2 Defendants.

3 **B. In The Alternative, Plaintiff's Copyright Claim Fails As To All**
4 **Defendants Because *Golddigger* Was a Joint Work under the Act.**

5 Even assuming Plaintiff has overcome the work for hire presumption,
6 Plaintiff's testimony, *at best*, indicates that the Wayans and Edwards co-authored
7 *Golddigger* as a "joint work" as that term is defined by the Act and as a result, the
8 Wayans possessed an undivided ownership interest in *Golddigger*. Although the
9 Wayans deny that Plaintiff contributed as he claims, even assuming what Plaintiff
10 claims is true, there is no cause for copyright infringement. If the Court finds that
11 based on Plaintiff's testimony, *Golddigger* is a joint work, then the Wayans and
12 SMP acted lawfully in contracting to publish the work and Plaintiff cannot
13 maintain a claim for copyright infringement claim against any of the Defendants.

14 **1. At Best, *Golddigger* Is a Joint Work under the Act.**

15 The Act defines a "joint work" as "a work prepared by two or more authors
16 with the intention that their contributions be merged into inseparable or
17 interdependent parts of a unitary whole." 17 U.S.C. § 101.⁴ In the Ninth Circuit,
18 the Court looks at three issues to determine joint authorship: (1) whether the work
19 consists of interdependent or inseparable components that were merged to create a
20 unitary whole, (2) whether the work was created by two or more authors with the
21 intention that their components be merged, and (3) whether each component is
22 independently copyrightable. *See Siegel v. Time Warner, Inc.*, 496 F. Supp. 2d
23 1111, 1144 (C.D. Cal. 2007); *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 521 (9th
24 Cir. 2000).

25
26
27 ⁴ Federal law is controlling on this issue. *See, e.g., Cambridge Literary Props., Ltd. v. W.*
28 *Goebel Porzellanfabrik G.m.b.H. & Co. Kg.*, 510 F.3d 77, 86 (1st Cir. 2007) ("Determination of
copyright ownership based on a disputed allegation of co-authorship presents a federal question
that arises under, and must be determined according to, the Copyright Act.").

1 a. *Golddigger illustrations and jokes are interdependent parts*
 2 *of a unitary whole.*

3 Components of a unitary work are considered “interdependent” when the
 4 parts “could stand alone but achieve greater effect when combined.” *Siegel*, 496 F.
 5 Supp. 2d at 1145 (citing the House Report submitted in connection with the
 6 passage of the 1976 Act). In *Siegel v. Time Warner, Inc.* (“*Siegel*”), this Court
 7 addressed the issue of whether a comic book created by two men—Siegel and
 8 Schuster—was a “joint work” for purposes of summary judgment. *See Siegel*, 496
 9 F.Supp.2d at 1144-1149. Siegel had written the text for the comic book while
 10 Shuster provided illustrations four years later. The Court held that the text and
 11 illustrations were interdependent parts of a unitary whole. *See Siegel*, 496
 12 F.Supp.2d at 1145 (holding that the comic book “would be considered comprised
 13 of interdependent parts—Siegel’s dialogue and storyline (as contained in his
 14 submissions) and Shuster’s artwork giving life and color to those words.”).

15 Similarly, *Golddigger* is comprised of jokes and illustrations/visualizations
 16 of those jokes which were merged to make one unitary work. (See SF 92; SR
 17 Decl, Ex. 1, “101 Ways to Know You’re a Golddigger”.) The illustrations bring to
 18 life the visual jokes and stir further interest by the readership. *See Aalmuhammed*
 19 *v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000) (noting that in a joint work “the
 20 audience appeal of the work turns on both contributions”). Accordingly, the first
 21 prong of the analysis is satisfied.

22 b. *Edwards Intended His Contribution to Be Merged With the*
 23 *Wayans at the Time of Creation.*

24 The touchstone of a joint authorship is an intention at the time of creation
 25 that the parts be combined into an integral unit. *Siegel*, 496 F.Supp.2d at 1145
 26 (citing the Senate Committee Report submitted with the passage of the 1976
 27 Copyright Act). The Court looks to objective evidence of this intention, but
 28 contemporaneous and coordinated action is not required. *Id.* at 1145-46.

1 Edwards expressly testified that when he drafted jokes for *Golddigger* he
 2 envisioned the jokes would “married with illustrations” (SF 56) created by the
 3 Wayans (and more specifically, by illustrators “on staff”). (SF 93.) And, although
 4 contemporaneous and coordinated action is not required for joint authorship,
 5 Edwards claims he did sit down to collaborate with the Wayans and their
 6 illustrators on at least one of the illustrations. (SF 94.) Edwards clearly intended
 7 his written contributions to be merged with illustrations by the Wayans to create
 8 *Golddigger*. See *Siegel*, 496 F.Supp.2d at 1145.

9 c. *Text and Illustrations Independently Copyrightable.*

10 In the Ninth Circuit, each contribution to a joint work must contain
 11 independently copyrightable material. See *Ashton-Tate Corp. v. Ross*, 916 F.2d
 12 516, 521 (9th Cir. 1990), but see *Gaiman v. McFarlane*, 360 F.3d 644, 658-59 (7th
 13 Cir. 2004) (declining to apply rule in mixed media situations). As a literary work,
 14 two requirements must be met to be considered copyrightable: it must be fixed in a
 15 tangible medium of expression; and it must be original. See 17 U.S.C. § 102(a).
 16 See also *Ashton-Tate Corp.*, 916 F.2d at 521 (noting that to be an author, “one
 17 must ‘translate[] an idea into a fixed tangible expression entitled to copyright
 18 protection.’”)(quoting *Reid*, 490 U.S. 730 (1989)).

19 Here, there is no dispute that the illustrations and jokes in *Golddigger* are
 20 each independent expressions that were reduced to fixed tangible expressions and
 21 thus could be copyrighted independently. Cf. *Siegel*, 496 F.Supp.2d at 1149
 22 (holding that the one factor precluding summary judgment was the lack of
 23 evidence was an issue of whether the comic book characters were derivate works
 24 or independently copyrightable).

25 2. To the Extent *Golddigger* is a Joint Work, Edwards Cannot
 26 Maintain a Claim for Copyright Infringement.

27 Each contributor to the joint work automatically acquires an undivided
 28 ownership in the entire work, including all of the contributions contained therein.

1 *Pye v. Mitchell*, 574 F.2d 476 (9th Cir. 1978); *M.G.B. Homes, Inc. v. Ameron*
 2 *Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990) (“equally entitled to claim a copyright
 3 in the undivided whole”); 1 NIMMER ON COPYRIGHT § 6.03 at 6-7. Because each
 4 contributor has an undivided ownership, each joint owner may freely publish the
 5 original or the revised work without the consent of the other co-contributors and
 6 without infringing their rights. *Oddo v. Ries*, 743 F.2d 630, 633 (9th Cir. Cal.
 7 1984) (holding that “each co-owner has an independent right to use the copyright”)
 8 (citing *Meredith v. Smith*, 145 F.2d 620, 621 (9th Cir. 1944)). Likewise, the co-
 9 contributor who publishes, licenses, or transfers the joint work to a third-party is
 10 not liable for copyright infringement, nor is the third-party who contracted to
 11 publish the work with the co-contributor. *Id.*

12 Therefore, to the extent Plaintiff did contribute to *Golddigger*, he did so in
 13 the context of creating joint work, which vested in the Wayans an undivided
 14 ownership interest in *Golddigger*. *See Oddo v. Ries*, 743 F.2d at 633. The Wayans
 15 were free to revise, license and publish *Golddigger* without Plaintiff’s consent.
 16 *See id.* Therefore, Plaintiff cannot maintain a claim for copyright infringement
 17 against any of the Defendants. *See id.*

18 **IV. PLAINTIFF’S STATE CLAIMS ARE PREEMPTED BY FEDERAL** 19 **COPYRIGHT LAW**

20 The Ninth Circuit has devised a two-part test to determine whether a
 21 particular state law claim is preempted by copyright law. *Del Madera Properties*
 22 *v. Rhodes & Gardner, Inc.*, 820 F.2d 973, 976 (9th Cir. 1987). First, it must be
 23 determined whether the work at issue is subject to the Copyright Act. The parties
 24 agree that *Golddigger* satisfies this requirement. Second, it must be determined if
 25 the state law claim is “equivalent to any of the exclusive rights within the general
 26 scope of copyright” as specified by the Act (17 U.S.C. §106). 17 U.S.C. § 301(a)
 27 (1982). “[T]o survive preemption, the state causes of action must protect rights
 28 which are qualitatively different from copyright rights. The state claim must have

1 an ‘extra element’ that changes the nature of the action.” *Del Madera*, 820 F.2d at
 2 977. It is therefore necessary to examine the state law claims alleged to determine
 3 if there is an “extra element” that provides protection outside the scope of
 4 copyright law. In order to do so, however, it must be determined which state’s law
 5 applies to Plaintiff’s unfair competition and breach of implied contract claims.

6 **A. California Law Applies and Plaintiff’s Unfair Competition Claim**
 7 **is Preempted as Against All Defendants.**

8 1. California Law Governs Plaintiff’s Unfair Competition Claim.

9 When a case has been transferred from another state’s federal court under 28
 10 U.S.C. § 1404(a), as is the case here, the choice-of-law provisions of the
 11 originating state govern. *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 243 n.8
 12 (1981). (See RJN, Ex. 1) This case originated in New York and was transferred to
 13 California 28 U.S.C. § 1404(a).⁵ Therefore, New York choice-of-law rules apply.
 14 In New York, the choice-of-law analysis “begins with a threshold determination as
 15 to whether an actual conflict of laws exists.” *GlobalNet Financial.Com, Inc. v.*
 16 *Frank Crystal & Co., Inc.*, 449 F.3d 377, 382 (2d. Cir. 2006).

17 a. *An Actual Conflict of Law Exists*

18 Under California law, an unfair competition claim is a statutory claim that
 19 limits recovery to restitution and injunctive relief, whereas, under New York law,
 20 unfair competition is a common law tort that permits the recovery of damages
 21 including punitive damages. Compare CAL. BUS. & PROF. CODE §§ 17200, 17203
 22 with *Getty Petroleum Corp. v. Island Transp. Corp.*, 878 F.2d 650, 657 (2nd Cir.
 23 1989) (holding that New York law “clearly permits punitive damages” for an
 24 unfair competition claim). Accordingly, a conflict of law exists. See *Curley v.*
 25 *AMR Corp.*, 153 F.3d 5, 12 (2nd Cir. 1998) (noting a conflict exists when “the
 26 applicable law from each jurisdiction provides different substantive rules”).

27
 28 ⁵ Notably, one factor used by the Court in determining whether to transfer the case was the
 application of California law to Plaintiff’s state law claims. (See SR Decl., Exs. A, B, and C.)

b. *New York's "Interest Analysis"*

For tort conflicts, New York uses an "interest analysis" requiring courts to give "controlling effect to the law of the jurisdiction which, because of its relationship or contact with the occurrence or the parties has the greatest concern with the specific issue raised in the litigation." *Babcock v. Jackson*, 12 N.Y.2d 473 (N.Y. 1963) (citations omitted). "Under this analysis, the court should focus almost exclusively on the parties' domiciles and the locus of the tort" (*Roselink Investors, L.L.C. v. Shenkman*, 386 F. Supp. 2d 209, 225 (S.D.N.Y. 2004)) and give the "greatest weight to those contacts which are relevant to the policies animating the particular rules in conflict." *Hamilton v. ACCU-TEK*, 47 F.Supp. 2d 330, 335-36 (E.D.N.Y. 1999).

Although New York and California have expressed substantive different rules regulating unfair competition, the purpose of an unfair competition claim in both states is similar: to deter misconduct and disgorge ill-gotten gains. *See Bank of the West v. Superior Court*, 2 Cal. 4th 1254, 1267 (Cal. 1992) (noting that under California law, the purpose of unfair competition claims is "to deter future violations . . . and to foreclose retention by the violator of its ill-gotten gains"); *Avon Periodicals, Inc. v. Ziff-Davis Pub. Co.*, 27 Misc. 2d 160, 164 (N.Y. Sup. Ct. 1952) ("[Unfair competition] seeks to prevent unfair and unconscionable advantages taken by one against his competitor"). To give effect to this common purpose, the Court should focus on the location of the alleged conduct giving rise to the claim. *See* RESTATEMENT (SECOND) OF CONFLICTS § 145, comment. f. It is undisputed that Plaintiff was a California employee and life-long resident, working in California for California employers. (SF 1-5, 49, 72.) Admittedly, the Wayans contracted with SMP to publish the 101 Series, a company based in New York (SF 95), but *Plaintiff* had *no* contact with SMP in New York or otherwise. (SF 96.) Moreover, to state a viable unfair competition claim, there must be something

1 more than mere publication of an alleged copyrighted work. *See, e.g., Del Madera*
 2 *Properties v. Rhodes & Gardner, Inc.*, 820 F.2d 973, 977 (9th Cir. 1987) (applying
 3 California law, *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 53 (2d Cir.), *cert.*
 4 *denied*, 476 U.S. 1159 (1986) (“Following this ‘extra element’ test, we have held
 5 that unfair competition and misappropriation claims grounded solely in the
 6 copying of a plaintiff’s protected expression are preempted by section
 7 301”); *Warner Bros. Inc. v. Am. Broadcasting Cos.*, 720 F.2d 231, 247 (2d Cir.
 8 1983)(same). Anything “more” must necessarily have taken place in California,
 9 where Plaintiff and the Wayans resided and worked. California—not New York—
 10 has the greatest interest in regulating the remedies available to employees of this
 11 state and regulating conduct of employers that operate in California. *Cf.*
 12 *Aalmuhammed v. Lee*, 202 F.3d 1227, 1237 (9th Cir. 2000) (noting that
 13 “California’s **interest** in protecting its residents from stale claims arising **from**
 14 **work done outside the state is a weak one** ... [and] New York’s **interest in**
 15 **governing the remedies available to parties working [in-state] in New York is**
 16 **far more significant**” (emphasis added)). Therefore, California law applies to
 17 Plaintiff’s unfair competition claim.

19 2. No Additional Element in Unfair Competition Claim

20 The Ninth Circuit has held that an allegation of unfair competition “does not
 21 add any ‘extra element’ which changes the nature of the action . . . [where it] is
 22 constructed upon the premise that the documents and information [] furnished to
 23 the defendants belonged to the [plaintiff] and were misappropriated by
 24 defendants.” *Del Madera Properties v. Rhodes & Gardner, Inc.*, 820 F.2d 973,
 25 977 (9th Cir. 1987). Plaintiff alleges in the Complaint that the “unauthorized
 26 *misappropriation* and misuse of Plaintiff’s book . . . constituted the wrongful
 27 deprivation of Plaintiff’s right to public recognition and credit as *author and owner*
 28 *of the book.*” (COMPL. ¶ 52.) Moreover, Plaintiff explicitly states that his “action

1 concerning Defendants' unfair competition is related to Plaintiff's substantial
 2 copyright infringement action since *both actions are based on the same operative*
 3 *facts.*" (COMPL. ¶ 54.) Plaintiff thus concedes and cannot contest that the unfair
 4 competition claim asserts rights equivalent to the copyright claim. Plaintiff's unfair
 5 competition claim is preempted by copyright law as against all of the Defendants.⁶

6 **B. Plaintiff's Breach of Implied Contract Claim is Preempted**

7 Similarly, Plaintiff's claim for breach of implied contract is preempted.

8 1. California Law Governs Breach of Implied Contract Claim

9 a. *An Actual Conflict of Law Exists*

10 At least one federal court has acknowledged that "[t]here are clear
 11 differences between New York and California common law rules with respect to
 12 breach of contract in general, and contract interpretation and performance in
 13 particular." *Twentieth Century Fox Film Corp. v. Marvel Enters.*, 155 F. Supp. 2d
 14 1, 13 (S.D.N.Y. 2001).

15 b. *New York's "Center of Gravity" Test*

16 For contract claims, New York uses the "center of gravity" test, focusing on
 17 "the place of contracting, the places of negotiation and performance, the location
 18 of the subject matter, and the domicile or place of business of the contracting
 19 parties." *Lazard Freres & Co. v. Protective Life Ins. Co.*, 108 F.3d 1531, 1539 &
 20 n.5 (2d Cir. 1997).

21 Although Plaintiff has not clearly articulated the basis for claiming an
 22 implied-in-fact contract existed, if any conduct gave rise to such an implied

23
 24 ⁶ Even if the Court concludes that New York law applies under New York's "interest analysis,"
 25 the result is the same. Plaintiff has failed to allege or provide evidence of an "extra element" that
 26 qualitatively changes the nature of his copyright infringement claim. *See Samara Bros. v. Wal-*
 27 *Mart Stores*, 165 F.3d 120, 131 (2d Cir. 1998) (quoting *Mayer v. Josiah Wedgwood & Sons, Ltd.*,
 28 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985) (holding that under New York law the "extra element"
 must change the "nature of the action so that it is qualitatively different from a copyright
 infringement claim."). Instead, Plaintiff has merely re-asserted his infringement claim. (*See*
 COMPL. ¶ 53.) Therefore, Plaintiff's unfair competition claim under New York is also preempted
 by federal copyright law.

1 contract, it must have occurred in California by and between California residents.
 2 Plaintiff admits he had zero contact with SMP and that SMP made him “no
 3 promises”. (SF 96.) There is no credible argument that New York law should
 4 apply based on SMP’s presence in New York. California law should apply to
 5 Plaintiff’s contract claim.

6 2. No Additional Element in Breach of Implied Contract Claim

7 Section 106 of the Copyright Act confers upon copyright owners the
 8 exclusive rights to reproduce, distribute and display original works of authorship,
 9 and to prepare works derived from the originals. 17 U.S.C. §106. When the
 10 gravamen of the claim is that the defendants used the plaintiff’s work, without
 11 authorization, the rights asserted under the implied contract are equivalent to the
 12 rights of copyright owners under section 106 of the Act – namely, the exclusive
 13 right to *use*. See, e.g., *Montz v. Pilgrim Films & Television*, 606 F.3d 1153, 1158
 14 (9th Cir. 2010); *Calente-Kritzer Video v. Pinckney*, 881 F.2d 772, 774 (9th Cir.
 15 1989).

16 An implied contract claim based on the conveyance of an “underlying idea”
 17 may survive preemption, in part, because ideas alone are not protected by
 18 copyright law. *Grosso v. Miramax Film Corp.*, 2004 U.S. App. LEXIS 28043 at
 19 *3 (9th Cir. Sept. 8, 2004). Such claims are referred to as *Desny* claims after the
 20 California Supreme Court case *Desny v. Wilder*, 46 Cal.2d 715 (Cal. 1956). To
 21 establish a *Desny* claim, the plaintiff must show that he prepared the work,
 22 disclosed the work to the offeree *for sale*, and did so under circumstances from
 23 which it could be concluded that the offeree voluntarily accepted the disclosure
 24 knowing the conditions on which it was tendered. See *Grosso v. Miramax*, 2004
 25 U.S. App. LEXIS at *3-4.

26 Here, Edwards has not alleged any facts that could establish a *Desny* claim.
 27 Plaintiff does not allege that the concept or idea of the work originated with him
 28 (See SF 56, SF 97.) To the contrary, Plaintiff knew that his employers were

engaged in creating the 101 Ways Series when he claims he prepared his work and dropped it off at Keenen Ivory Wayans's home. (SF 59, 86-89.) The gravamen of Plaintiff's claim is that Defendants violated Plaintiff's asserted right to use and authorize the use of content he claims belonged to him. (See COMPL. ¶ 56 (asserting Plaintiff's "property interest" in *Golddigger* and his alleged "understanding" that "any use" by Defendants would be "subject to notification and consent by Plaintiff and compensation for use thereof").) The right to use and authorize the use of creative work is expressly within the exclusive domain of copyright law. See 17 U.S.C. § 106. Plaintiff's breach-of-implied contract claim is, accordingly, preempted by federal copyright law.

V. STATE LAW CLAIMS FAIL AS A MATTER OF LAW.

A. Plaintiff's Contract Claim Fails as to All Defendants.

In order to establish an implied in fact contract, the party asserting it must allege and prove existence of conduct from which a binding contract may be inferred. See, e.g., *Foley v. Interactive Data Corp.*, 47 Cal. 3d 654, 676, fn. 20 (Cal. 1988). Here, Plaintiff only generally and vaguely alleges that "[a]t all relevant times, an implied contract existed between Plaintiff and Defendants" (COMPL. ¶ 57.) Plaintiff does not identify any conduct on the part of *any* of the Defendants that would give rise to an implied-in-fact contract. (See COMPL. ¶¶ 56-58.)

Plaintiff expressly states that he had no interactions with SMP (265:5-266:10; 266:18-267:16) and that SMP did not make any promises to him. (270:12-21) Therefore, Edwards cannot set forth any evidence that would establish that he had an implied-in-fact contract with SMP. In addition, Plaintiff admits that he has no understanding or agreement with the Wayans with respect to confidentiality or payment when he allegedly dropped off his manuscript. (SF 59.) Accordingly, Plaintiff's claim for breach of contract fails as a matter of law.

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B. Plaintiff's Unfair Competition Claim Fails

An unfair competition claim is essentially a common law copyright infringement claim, where, as Plaintiff admits, it is based on the "same operative facts" as his copyright infringement action. (*See* COMPL. ¶54.) Plaintiff's Complaint asserts that the "unauthorized misappropriation" of "Plaintiff's book" constituted a "wrongful deprivation" of his right to "credit as author and owner of the book." (COMPL. ¶56.) Plaintiff's unfair competition claim is thus based on his purported assumption that he had an exclusive ownership interest in jokes he allegedly drafted for inclusion in *Golddigger* while he was employed by the Wayans. This assumption, however, is entirely without legal or factual support.

As discussed above, Plaintiff was a full-time employee of the Wayans at the time the underlying work was created, and if Plaintiff wrote jokes to be included in *Golddigger*, he did so within the scope of his employment on a work-for-hire basis. (*See, supra*, Section III.A.) The work is thus owned by the Wayans in its entirety. A common law copyright infringement or misappropriation theory of liability fails as a matter of law. Further, by extension, the unfair competition claim fails as a matter of law also against SMP who cannot be said to have committed any wrongdoing in contracting with the exclusive copyright owners to publish the 101 Ways Series.

VI. IN THE ALTERNATIVE, THE COURT SHOULD GRANT SUMMARY ADJUDICATION WITH RESPECT TO DAMAGES.

To the extent that the Court does not grant summary judgment as to Plaintiff's entire claims, the Court should issue an order summarily adjudicating the issue of what types of damages and costs are recoverable by Plaintiff. *See* FED. R. Civ. P. 56(b).

A. No Statutory Damages or Attorneys' Fees under Copyright Act.

Plaintiff seeks punitive damages, statutory damages, and attorneys' fees in connection with his copyright claim. (COMPL. ¶ 59, B, E, F, G.) When the work

1 that is the subject of a copyright claim has not been published, as is the case with
 2 Plaintiff's manuscript, registration of the copyright prior to commencement of the
 3 alleged infringement is a prerequisite to recovery of attorneys' fees and statutory
 4 damages under the Act. *See* 17 U.S.C. § 412. *See also Streeter v. Rolfe*, 491 F.
 5 Supp. 416, 421 (W.D. La. 1980) (holding that Section 412(2) "applies only to
 6 published works"). Plaintiff cannot elect to recover statutory damages because his
 7 alleged copyrighted work—the manuscript attached to the Complaint as Exhibit
 8 1—was unpublished and not registered with the U.S. Copyright Office at the time
 9 of the alleged infringement. *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189,
 10 197 (S.D.N.Y. 2006) ("In view of the foregoing, the complaint fails to allege facts
 11 that, if proved, would permit the conclusion that the work has been published. In
 12 consequence, Section 412(1) precludes recovery of statutory damages or attorney
 13 fees for the alleged infringements prior to December 10, 2004, the effective date of
 14 the copyright registration.") Therefore, Plaintiff is ineligible to recover statutory
 15 damages and attorneys' fees. *See* 17 U.S.C. § 412.

16 Moreover, absent an election for statutory damages, punitive damages are
 17 not recoverable under the Act. *See Davis v. Gap, Inc.*, 246 F.3d 152, 172 (2d Cir.
 18 2001) ("As a general rule, punitive damages are not awarded in a statutory
 19 copyright infringement action.") (citing 4 NIMMER ON COPYRIGHT § 14.02 B, at 14-
 20 23 to 24; *Oboler v. Goldin*, 714 F.2d 211, 213 (2d Cir. 1983)). To the extent
 21 Plaintiff may maintain a copyright claim at all, Plaintiff is foreclosed from
 22 recovery of statutory damages or attorneys' fees.

23 **B. No Damages or Attorneys' Fees for Unfair Competition.**

24 It is well-settled that in California, a private litigant may not recover attorney
 25 fees or damages, including punitive damages, for unfair competition. CAL. BUS. &
 26 PROF. CODE § 17203. *See also Korea Supply Co. v. Lockheed Martin Corp.*, 29
 27 Cal. 4th 1134, 1147-1148 (Cal. 2003). To the extent Plaintiff may maintain an
 28 unfair competition claim, he is prohibited from recovery of attorneys' fees or

1 damages in connection therewith. *See, e.g., Pacific MDF Prods. v. Bio-Mass*
 2 *Energy Concepts, LLC*, 2006 U.S. Dist. LEXIS 89844, at *26-27 (Nov. 17, 2006
 3 E.D. Cal.) (granting summary adjudication on damages for unfair competition).

4 **C. No Attorneys' Fees or Punitive Damages for Breach of Contract.**

5 California law clearly prohibits recovery of punitive damages for a claim
 6 sounding in contract. CAL. CIV. CODE § 3294(a). Moreover, attorneys' fees are
 7 not recoverable unless provided by a statute, law or the terms of the contract. CAL.
 8 CIV. PRO. § 1033.5 (a)(10). Plaintiff has not, and cannot, reference any term of the
 9 contract, statute or law that permits recovery of attorneys' fees in connection with
 10 his breach of contract claim.⁷ (COMPL. ¶¶12-38, 56-58.) Accordingly, Plaintiff
 11 cannot recover either in connection with his third cause of action.

12 **VII. CONCLUSION**

13 Based on the foregoing, all Defendants are entitled to summary judgment as
 14 a matter of law on each of Plaintiff's causes of action. Further, and in the
 15 alternative, all Defendants are entitled to an order precluding Plaintiff from
 16 recovering (1) statutory damages or attorneys' fees in connection with Plaintiff's
 17 first cause of action; (2) non-restitutionary relief in connection with Plaintiff's
 18 second cause of action, and (3) attorneys fees or punitive damages in connection
 19 with Plaintiff's third cause of action for breach of implied in fact contract claim.

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 27 ⁷ Under New York law, Plaintiff is also precluded from recovery. *See Locascio v. Aquavella*,
 28 185 A.D.2d 689 (N.Y. App. Div. 4th Dep't 1992) ("in the absence of a statutory or contractual
 basis for payment of attorney's fees they are generally not recoverable"); *Umfrey v. NeMoyer*,
 184 A.D.2d 1047, 1048 (N.Y. App. Div. 4th Dep't 1992) (same).

1 Dated: December 17, 2010 FREEDMAN & TAITELMAN, LLP

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